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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,109

Applicant(s)

BANERJEE ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. This action is in response to the application filed on June 28, 2001. Claims 1-38 are pending.

Claim Objections

2. Claim 1, 9-10, 14, 16, 19-20, 23, 31-32, 36 and 38 are objected to because of the following informalities:

- a) In line 4 of claim 1, the phrase "the registered content items" should be "the previously registered content items";
- b) In line 1 of claim 9, the phrase "content purchase" should be "content purchaser";
- c) In line 4 of claim 9, the phrase "the Web page" should be "Web page";
- d) In line 5 of claim 9, the phrase "content controller server" should be "content controller system";
- e) In line 2 of claim 10, the phrase "the new content and registered content" should be "the additional content item and previously registered content items";
- f) In line 4 of claim 10, the phrase "the registered content items" should be "the previously registered content item";
- g) In lines 5-6 of claim 10, the phrase "the proposed distribution parameters conflict with the distribution parameters of the registered content" should be "the distribution parameters of the additional content item conflict with the distribution parameters of the previously registered content items";

- h) In line 3 of claim 14, the phrase "content controller server" should be "content controller system";
- i) In lines 4-5 of claim 14, the phrase "the proposed distribution parameters conflict" should be "the distribution parameters of the additional content item conflict";
- j) In line 2 of claim 16, the phrase "the proposed distribution parameters" should be "proposed distribution parameters", or "the distribution parameters of the additional content item";
- k) In line 3 of claim 16, the phrase "business policy parameters of the content controller" should be "business parameters of the content controller system";
- l) Claim 19 should end with a period (.);
- m) Claim 20 should end with a period (.);
- n) In line 4 of claim 23, the phrase "the registered content" should be "the previously registered content";
- o) In line 2 of claim 31, the phrase "content purchase" should be "content purchaser";
- p) In line 4 of claim 31, the phrase "the Web page" should be "Web page";
- q) In line 5 of claim 31, the phrase "content controller server" should be "a content controller server";
- r) In lines 2-3 of claim 32, the phrase "the new content and registered content" should be "the additional content item and previously registered content items";

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- s) In line 5 of claim 32, the phrase "the registered content items" should be "the previously registered content item";
- t) In lines 6-7 of claim 32, the phrase "the proposed exclusive distribution parameters conflict with the exclusive distribution parameters of the registered content" should be "the exclusive distribution parameters of the additional content item conflict with the exclusive distribution parameters of the previously registered content items";
- u) In line 3 of claim 36, the phrase "content controller server" should be "a content controller server";
- v) In lines 4-5 of claim 36, the phrase "the proposed exclusive distribution parameters conflict" should be "the exclusive distribution parameters of the additional content item conflict";
- w) In line 2 of claim 38, the phrase "the proposed exclusive distribution parameters" should be "proposed exclusive distribution parameters", or "the exclusive distribution parameters of the additional content item";
- x) In line 3 of claim 38, the phrase "business policy parameters of the content controller" should be "business parameters of the content controller server".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claims 1, 3-4 and 10-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claim 1 only recites an abstract idea. The recited steps merely claim registering the additional content item if it is determined that there is no conflict between the additional content item and the previously registered content items. These recited steps do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to registering new content without conflict with the existed contents.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject

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matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps in claim 1 is directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "on-line with a content controller system". Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, claim 1 determines if there is conflict between the new content and the existed contents, and registering the new content if there is no conflict.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

The dependent claims 3-4 and 10-16 are not within the technological arts. As discussed above, mere recitation in the preamble (i.e. intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble; thus, claims 3-4 and 10-16 are also deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3-4, 12, 17, 20-23, 25-26 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by McCoy et al., U. S. Patent 6,526,575.

As to claims 1 and 23, McCoy teaches a method for making syndicated content available on-line with a content controller system, and a computer program product including instructions embodied on a computer readable medium, comprising (column 10 lines 34-41, 63 – column 11 line 7):

- a) maintaining a database of previously registered content items and distribution parameters associated with each of the registered content items (column 16 line 53 – column 17 line 1 and Figs. 18-19; *specifically, “previous registered content items” correspond to the global absolute schedule and the local absolute schedule in the first and the second skeleton in McCoy’s teaching, and “distribution parameters” correspond to the time and date information that associated with the global and the local absolute schedule*);
- b) receiving a request to register an additional content item with associated distribution parameters (column 16 line 53 – column 17 line 1 and Figs. 18-19;

specifically, “an additional content item” corresponds the absolute rate schedule in the third skeleton in McCoy’s teaching, and “distribution parameters” correspond to the time, date or frequency that associated with the absolute rate schedule);

c) determining whether there is a conflict between the distribution parameters of the additional content item and distribution parameters of previously registered content items (column 16 line 53 – column 17 line 1 and Figs. 18-19);

d) registering the additional content item if there is no conflict (column 16 line 53 – column 17 line 1 and Figs. 18-19; *specifically, this limitation corresponds to allowing the absolute rate schedule to be added to the scheduling if it is not conflict with the global and local absolute schedule).*

As to claims 3, 20 and 25, McCoy teaches the registered content items are selected from films, sporting events, music performances, entertainment, information, video feeds, audio feeds, television broadcasts, and combinations thereof (column 5 line 41 – column 6 line 5 and column 14 lines 31-34).

As to claims 4, 21 and 26, McCoy teaches the distribution parameters are selected from pricing of the content for a purchaser, time period for distribution of the content, geographical areas to distribute or not to distribute the content, the bandwidth over which the content may be distributed, content description and classification, and combinations thereof (column 5 lines 56-59 and column 10 lines 15-24 and column 12 lines 37-56 and column 14 lines 25-30 and column 16 line 53 – column 17 line 1).

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As to claims 12 and 34, McCoy teaches the request to register is received from a content provider selected from a new content provider and a current content provider (column 16 line 53 – column 17 line 1 and column 19 line 63 – column 20 line 31).

As to claim 17, McCoy teaches a system for controlling online content distribution comprising (abstract):

- a) a content controller server (item 102 in Fig. 1),
- b) at least one database containing registered content, registered content distribution parameters, content distributor business policy parameters, and purchaser parameters (column 9 lines 49-67 and column 11 line 64 – column 12 line 3 and column 16 line 53 – column 17 line 1 and column 22 lines 20-27 and Figs. 4-11);
- c) a parameter conflict detector, wherein new content having distribution parameters not in conflict with the distribution parameters of registered content is registered and made available to purchasers (column 16 line 53 – column 17 line 1 and Figs. 18-19; *specifically, “new content” corresponds to the absolute rate schedule in the third skeleton in McCoy’s teaching, and “registered content” corresponds to the global and the local absolute schedule in the first and the second skeleton*).

As to claim 22, McCoy teaches purchaser properties are selected from purchaser identification, demography or combinations thereof (column 9 lines 49-67).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 5-8, 24 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al., U. S. Patent 6,526,575 in view of Clark, U. S. Patent 5,311,423.

As to claims 2 and 24, McCoy teaches further teaches:

e) receiving a request from an online content purchaser to purchase a specific registered content item (column 1 lines 32-44; specifically, purchase a specific registered content item corresponds to subscribing a pay-per-view event).

McCoy does not explicitly teach: f) identifying one or more properties of the online content purchaser, g) determining whether there is a conflict between the one or more properties of the online content purchaser and the distribution parameters associated with the specific registered content item, and h) delivering the specific registered content item to the online content purchaser if there is no conflict. However, Clark teaches identifying one or more properties of the online content purchaser (column 7 lines 40-50 and column 8 lines 24-29), determining whether there is a conflict between the one or more properties of the online content purchaser and the distribution parameters associated with the specific registered content item (column 7 lines 40-50 and column 21 line 63 – column 22 line 9), and delivering the specific registered content

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item to the online content purchaser if there is no conflict (column 7 lines 40-50 and column 21 line 63 – column 22 line 9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow online purchasing process in McCoy's teaching to further include the features taught by Clark for better distributing the specific registered content items to the purchaser.

As to claims 5 and 27, McCoy teaches the one or more properties of the online content purchaser are selected from purchaser identification, demography or combinations thereof (column 9 lines 49-67).

As to claims 6 and 28, McCoy further teaches:

- i) allowing the online content purchaser to access the content controller system (Figs. 12-17);
- j) collecting information from the purchaser (column 9 lines 58-67 and Figs. 6-7);
- k) storing the collected information in a purchaser database on the content controller system, wherein the collected information is selected from purchaser properties (column 9 lines 58-67 and Figs. 6-7).

As to claims 7 and 29, McCoy teaches purchaser properties are selected from purchaser identification, geographical location, demography or combinations thereof (column 9 lines 58-67).

As to claims 8 and 30, McCoy teaches storing the purchaser's information in the purchaser database (column 9 lines 58-67 and Figs. 6-7). McCoy does not specifically teach issuing a user identification and password to the purchaser for accessing the

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content controller system, and storing the user identification and password in the purchaser database. However, Clark teaches the purchaser having a user identification and password for access contents (column 7 lines 46-50 and column 8 lines 25-26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the purchaser's information in McCoy's teaching to include a user identification and password because this would prevent unauthorized access of the content.

9. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al., U. S. Patent 6,526,575 in view of Ansell et al., U. S. Patent 6,151,631.

As to claim 18, McCoy further teaches:

- a) maintaining geographical location information of the purchaser (column 9 lines 58-67);
- b) a business policy parameter conflict detector, wherein new content having distribution parameters not in conflict with the business policy parameters is registered and made available to purchasers (column 22 lines 20-27).

McCoy does not explicitly teach a purchaser geography detector that identifies the purchaser's geographical location. However, Ansell teaches this matter (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow McCoy's teaching to include a purchaser geography detector that identifies the purchaser's geographical location as taught by Ansell because this would quickly determine the location of the purchaser and to ensure securely delivering the content to the purchaser according to the business policy parameters.

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As to claim 19, McCoy teaches the business policy parameters are selected from objectionable content ban (column 22 lines 20-26).

10. Claims 9 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al., U. S. Patent 6,526,575 in view of Clark, U. S. Patent 5,311,423 in further view of Ansell et al., U. S. Patent 6,151,631.

As to claims 9 and 31, McCoy modified by Clark further teaches the one or more properties of the online content purchase include the geographical location of the purchaser (McCoy: column 9 lines 58-67). McCoy modified by Clark does not explicitly teach the geographical location is identified by a method selected from asking the purchaser to provide the geographical location on the Web page and determining the location automatically through the purchaser's IP address by the content controller server. However, this matter is taught by Ansell as identifying the purchaser's geographical location by determining the purchaser's IP address (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the graphical location of the purchaser in the teaching of McCoy modified by Clark to include the feature of identifying the geographical location by determining the IP address of the purchaser as taught by Ansell because this would allow the content control system to quickly determine the location of the purchaser and to ensure securely delivering the content to the purchaser.

11. Claims 10-11, 13-16, 32-33 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al., U. S. Patent 6,526,575 in view of Haddad, U. S. Patent 5,835,843.

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As to claims 10 and 32, McCoy teaches determining whether there is conflict between the distribution parameters of the new content and registered content as discussed in claim 1 above. McCoy does not explicitly teach e) comparing the requested distribution parameters with the distribution parameters of the registered content items, and f) denying registration of the additional content item if the proposed distribution parameters conflict with the distribution parameters of the registered content. However, this matter is taught by Haddad as comparing a customer request for a particular video segment with the current existing schedules, rejecting the customer request if there is a conflict (column 9 lines 5-9 and column 10 lines 13-26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow McCoy's teaching to include the features of comparing the requested distribution parameters with the distribution parameters of the registered content items, and denying registration of the additional content item if the proposed distribution parameters conflict with the distribution parameters of the registered content for quickly determining if it is possible to satisfy registration request for the additional content item.

As to claims 11 and 33, McCoy teaches determining whether there is conflict between the distribution parameters of the additional content item and the previously registered content items as discussed in claim 1 above. McCoy does not specifically teach receiving a modified request to register the additional content item with modified distribution parameters to remove conflict with the distribution parameters of the registered content. However, this matter is taught by Haddad as modifying the customer's scheduling request for a particular video segment by removing the conflict

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(column 10 lines 13-23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow McCoy's teaching to further include the feature of modifying the request for registering the additional content item by removing the conflict with the previously registered content items for quickly resolving the conflict, and thus to satisfy the customer's request with an alternative solution. McCoy further teaches repeating steps c and d (column 16 line 53 – column 17 line 1 and Figs. 18-19).

As to claims 13 and 35, McCoy teaches the request to register provides the requested distribution parameters in computer readable format to the content controller server (column 19 line 63 – column 20 line 31 and Figs. 1-3).

As to claims 14 and 36, McCoy teaches determining whether there is conflict between the distribution parameters of the new content and registered content as discussed in claim 1 above. McCoy does not explicitly teach e) comparing the requested distribution parameters with the business parameters established for the content controller server, and f) denying registration of the additional content item if the proposed distribution parameters conflict with the business parameters. However, this matter is taught by Haddad as comparing a customer request for a particular video segment with the current existing schedules, rejecting the customer request if there is a conflict (column 9 lines 5-9 and column 10 lines 13-26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow McCoy's teaching to include the features of comparing the requested distribution parameters with the business parameters established for the content controller server, and denying registration of the additional content item if the proposed distribution parameters conflict

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with the business parameters because this would quickly determine if it is possible to satisfy registration request for the additional content item.

As to claims 15 and 37, McCoy teaches the business parameters are selected from objectionable content (column 22 lines 20-26).

As to claims 16 and 38, McCoy teaches determining whether there is conflict between the distribution parameters of the additional content item and the previously registered content items as discussed in claim 1 above. McCoy does not specifically teach modifying the proposed distribution parameters to remove conflict with the business policy parameters of the content controller. However, this matter is taught by Haddad as modifying the customer's scheduling request for a particular video segment by removing the conflict (column 10 lines 13-23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow McCoy's teaching to further include the feature of modifying the proposed distribution parameters to remove conflict with the business policy parameters of the content controller because this would quickly resolve the conflict, and thus to satisfy the customer's request with an alternative solution. McCoy modified by Haddad further teaches repeating steps c through f (see claims 1, 14, 23 and 36 above).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Thomas et al. (U. S. Patent 5,425,100) discloses a multi-level encoded signal monitoring system.

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Nishigaya et al. (U. S. Patent 5,594,902) discloses a custom service control system.

Miller et al. (U. S. Patent 5,920,701) discloses data from one or more content sources over a network to one or more replicated servers is scheduled and performed according to the schedule.

Walker et al. (U. S. Patent 6,209,028) discloses synchronizing the audio component of the television program so that there is no conflict.

Horlander et al. (U. S. Patent 6,507,953) discloses scheduling between first and second video processing devices.

Peled et al. (WO 03/038695 A1) discloses distributing digital content or services.

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Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Mary Cheung
Patent Examiner
Art Unit 3621
February 6, 2004

